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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,563	05/10/2001	Hirokazu Uchio	B422-150	6252
26272 7590 05/31/2007 COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER ABEL JALIL, NEVEEN	
			ART UNIT 2165	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/852,563

Applicant(s)

UCHIO ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-31,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-31,36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Remarks**

1. In response to Applicant's Amendment filed on March 12, 2007, claim 32 has been cancelled. Claims 36, and 37 have been newly added. Therefore, claims 27-31, 36, and 37 are now pending in the application.
2. Applicant's Amendment has overcome the previous rejections under 35 USC 101, and 112, second paragraph, and claim objections.

### ***Claim Objections***

3. Claims 27, and 31, are objected to because of the following informalities:

Claims 27, and 31, line 9, recite "can be" which constitutes intended use making the functionality following not carry any patentable weight since it never actually has to take place. Claims should be amended to recite more direct and positive language such as "is", "are", "to", or "that". Correction is required.

Claim 31, line 15, recite "so that" which constitutes intended use making the functionality following not carry any patentable weight since it never actually has to take place. Claims should be amended to recite more direct and positive language such as "is", "to", or "that". Correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 27, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite “substantially equivalent” which is a relative and indefinite term thus failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It’s unclear how or when the determination is made that the content is “substantially equivalent” and what constitutes equivalence or relevance? Clarification is required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 27-31, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindh (U.S. Pub. No. 2002/0022974 A1) in view of Leedom, Jr. (U.S. Patent No. 5,329,447).

As to claims 27, and 31, Lindh discloses an information processing method, and system to display a prior art document relating to a patent application to be or being prosecuted comprising the steps of:

an input unit configured to input a prior art document of a second patent application to be or being prosecuted in a second country with a document number, wherein the document number can be the patent number in the case of an issued patent and the publication number in the case of a published patent application, and wherein the second patent application is in a family of a first patent application to be or being prosecuted in a first country, the family of the first patent application including a group of one or more patent applications each of which having a content substantially equivalent to the content of the first patent application (See Lindh page 1-2, paragraphs 0018, and 0023-0024);

a server configured to store the prior art document of the second patent application with the document number input by said input unit via a network, wherein the prior art document input by said input unit becomes readable by using the document number (See page 4, paragraphs 0039-0040, wherein all citation information is stored in the database is taught);

a display unit configured to display the first patent application to be or being prosecuted together with both the document number of the prior art of the second patent application and country information of the second patent application on a common screen, the document number of the prior art of the second patent application and the country information of the second patent application being obtained from the server (See pages 1-2, paragraph 0018, and see page 2, paragraphs 0023-0024).

Lindh teaches the claimed invention expect for display the actual reference number a case number being the reference number of a company.

Leedom, Jr. teaches display the actual reference number a case number being the reference number of a company (See Figure 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Lindh by the teachings of Leedom, Jr. to include the actual reference number a case number being the reference number of a company because it provides for linkage and customization to better display of patent related information.

As to claim 28, Lindh as modified discloses wherein said display control unit displays a flag indicating whether or not a prior art disclosure procedure has been performed on the prior art document (See Lindh page 3, paragraph 0032).

As to claim 29, Lindh as modified discloses wherein said display control unit displays descriptions indicating correspondence between the prior art document and a rejection reason (See Lindh page 2, paragraph 0026, also Lindh page 3, paragraph 0036).

As to claim 30, Lindh as modified discloses wherein said display control unit displays a list of applications by which the prior art document has been cited relating to the prior art document (See Lindh page 2, paragraph 0018, column 1, teaches variety of display choices including related patents, prior art, country, etc.).

As to claims 36, and 37, Lindh as modified discloses herein said display unit displays a flag indicating whether or not a document or information disclosure statement citing the prior art document has been filed in the prosecution of the first patent application in the first country (See Lindh page 3, paragraph 0032).

Alternatively, the claims are rejected under:

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 27-31, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (U.S. Patent No. 5,991,751) in view of Leedom, Jr. (U.S. Patent No. 5,329,447).

As to claims 27, and 31, Rivette et al. discloses an information processing method, and system to display a prior art document relating to a patent application to be or being prosecuted comprising the steps of:

an input unit configured to input a prior art document of a second patent application to be or being prosecuted in a second country with a document number, wherein the document number can be the patent number in the case of an issued patent and the publication number in the case of a published patent application, and wherein the second patent application is in a family of a

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first patent application to be or being prosecuted in a first country, the family of the first patent application including a group of one or more patent applications each of which having a content substantially equivalent to the content of the first patent application (See Figure 57, shows assignee name, sorting patents related to assignee, also see Figure 61, you can sort patents by assignee related to type of invention and related patent numbers, and see column 102, lines 20-40);

a server configured to store the prior art document of the second patent application with the document number input by said input unit via a network, wherein the prior art document input by said input unit becomes readable by using the document number (See Figure 117, and see Figure 61, and see Figure 125);

a display unit configured to display the first patent application to be or being prosecuted together with both the document number of the prior art of the second patent application and country information of the second patent application on a common screen, the document number of the prior art of the second patent application and the country information of the second patent application being obtained from the server (See Figure 13, and see Figure 125, and see Figure 154A, wherein "Patent Number" and /or application Number is displayed as well as related prior art cited both US and Foreign, and wherein "actual reference number" reads on "Document #").

Rivette et al. teaches the claimed invention expect for display the actual reference number a case number being the reference number of a company.

Leedom, Jr. teaches display the actual reference number a case number being the reference number of a company (See Figure 3).



Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Rivette et al. by the teachings of Leedom, Jr. to include the actual reference number a case number being the reference number of a company because it provides for linkage and customization to better display of patent related information.

As to claim 28, Rivette et al. as modified discloses wherein said display control unit displays a flag indicating whether or not a prior art disclosure procedure has been performed on the prior art document (See Rivette et al. column 49, lines 46-67, and see Rivette et al. column 50, lines 1-64).

As to claim 29, Rivette et al. as modified discloses wherein said display control unit displays descriptions indicating correspondence between the prior art document and a rejection reason (See Rivette et al. column 90, lines 51-64, also see Rivette et al. column 117, lines 25-40, wherein "patent case" includes prosecution history).

As to claim 30, Rivette et al. as modified discloses wherein said display control unit displays a list of applications by which the prior art document has been cited relating to the prior art document (See Rivette et al. Figure 61, also see Rivette et al. column 118, lines 34-41).

As to claims 36, and 37, Rivette et al. as modified discloses herein said display unit displays a flag indicating whether or not a document or information disclosure statement citing

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the prior art document has been filed in the prosecution of the first patent application in the first country (See Rivette et al. column 49, lines 46-67, and see Rivette et al. column 50, lines 1-64).

***Response to Arguments***

11. Applicant's arguments with respect to claims 27-31, 36, and 37 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Neveen Abel-Jalil  
May 27, 2007